

Appl. No. 09/655,755
Amdt. Dated December 28, 2004
Reply to Office action of September 7, 2004
Attorney Docket No. P12103-US1
EUS/JIP/04-2204

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicant has amended claims 1-2 and 4-22 to more particularly point out and distinctly claim the subject matter regarded as the invention; no new matter has been added by these amendments. Claims 1-22 remain pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Allowable Subject Matter

The Examiner objected to claims 5 and 15 as being dependent upon rejected base claims, but indicated such claims would be allowable if rewritten in independent form, including all of the limitations of their respective base claims (Claims 1 and 13) and any intervening claims. The Applicant thanks the Examiner for the indication of allowable subject matter. Whereas the Applicant believes claims 1 and 13 recite allowable subject matter, however, the Applicant declines to rewrite claims 5 and 15 in independent form.

3.) Examiner Objections - Claims

The Examiner objected to claims 1-22 because of certain informalities. The Applicant has amended the claims substantially as suggested by the Examiner. The Examiner's consideration of the amended claims is respectfully requested.

4.) Claim Rejections - 35 U.S.C. §112

The Examiner rejected claims 10-12 and 20-22 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant has amended those claims to correct the lack of antecedent bases noted by the Examiner. The Examiner's consideration of the amended claims is respectfully requested.

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5.) Claim Rejections – 35 U.S.C. § 102(e)

The Examiner rejected claims 1-4, 6-14, and 16-22 as being anticipated by United States Patent No. 6,459,914 B1 issued to Gustafsson *et al.* The Applicant traverses the rejection.

As noted in response to the prior Office Action, for Gustafsson to anticipate the claimed invention, it must not merely approximate or be almost the same as the invention, but there must be an identity of invention between it and the claim. Anticipation requires the presence in the Gustafsson disclosure of all elements of the claimed invention arranged as in the claim. The claim limitations which must be met are those set forth in each element, and such a limitation cannot be met by an element in Gustafsson that performs a different function, even though it may be part of a device embodying the same general overall concept. See, *RCA Corp. v. Applied Digital Data Sys., Inc.* 221 USPQ 385, 389 n.5 (Fed. Cir. 1984).

In response to Applicant's prior arguments that Gustafsson fails to anticipate the claimed invention because the invention claimed by Applicant depends upon a specific structural arrangement, or ordering of the performance, of claim limitations, the Examiner merely responded that "[t]he specific ordering of the performance of claim limitations is established by the structure of elements in the claim, such as the relationship of the input that the limitation works upon/takes in, not merely by the ordering the limitations listed in the claim." As noted in Applicant's prior arguments, however, each of the limitations of claim 1 recite functionality that is dependent upon prior claim limitations; i.e., the ordering of the performance of the claim limitations is established by other than the mere ordering of the limitations listed in the claim. In order to make such ordering more explicit, however, the Applicant has amended claim 1, to wit:

1. A method of designing a digital filter, including the steps of:
first, determining a real-valued discrete-frequency representation of a desired full length digital filter;
second, transforming said real-valued discrete-frequency representation into a corresponding discrete-time representation;
third, circularly shifting said discrete-time representation; and

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fourth, applying a shortening window to said discrete-time representation to produce a zero-padded reduced length filter.

Each of the limitations of claim 1 now recite functionality that is explicitly dependent upon prior claim limitations. Although claim 1 contain terms which the Examiner has related to similar terms distributed throughout Gustafsson, the functionality embodied by the limitations of the claim, taken as a whole, is not disclosed by Gustafsson. This is apparent by noting that the Examiner's references to portions of Gustafsson for each claim limitation are not ordered sequentially, but are taken from random portions of Gustafsson. For example, with respect to the first limitation (determining a real-valued discrete-frequency representation of a desired full length digital filter), the Examiner makes reference to column 6, lines 15-30 of Gustafsson; with respect to the second limitation (transforming said discrete-frequency representation into a corresponding discrete-time representation), the Examiner makes reference to column 8, lines 16-24 of Gustafsson; with respect to the third limitation (circularly shifting said discrete-time representation), the Examiner makes reference to column 7, line 55 to column 8, line 25 of Gustafsson; and, with respect to the fourth limitation (applying a shortening window to said discrete-time representation to produce a zero-padded reduced length filter), the Examiner makes reference to column 8, lines 18-33 of Gustafsson; *i.e.*, the Examiner jumps from column 6 to column 8, back to column 7, and then forward to column 8. Accordingly, Gustafsson is obviously not disclosing the invention claimed by Applicant, which depends upon an explicit and specific ordering of the performance of claim limitations.

The Examiner has based the rejection on apparently similar terms used in Gustafsson, without taking into consideration the invention as a whole. As noted previously, there must be an identity of invention, which requires the presence in Gustafsson of all elements of the claimed invention arranged as in the claim. Whereas the Examiner has failed to consider the functionality of each claim limitation, and the relation of each limitation to the invention as a whole, the Examiner has not established that Gustafsson anticipates claim 1. Accordingly, Gustafsson fails to anticipate claim 1.

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The Applicant has also amended claim 7 to explicitly state the ordering of performance of the claim limitations, which are analogous to those of claim 1. Furthermore, the Applicant has amended claims 13 and 17 to provide for an explicit structural arrangement between the means limitations, analogous to the ordering of performance of the claim limitations of claim 1. Therefore, whereas claims 7, 13 and 17 recite limitations analogous to claim 1, those claims are also not anticipated by Gustafsson. Furthermore, whereas claims 2-4 and 6 are dependent from claim 1; claims 8-12 are dependent from claim 7, claims 14 and 16 are dependent from claim 13, and claims 18-22 are dependent from claim 17, and include the limitations of their respective base claims, those claims are also not anticipated by Gustafsson. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 1-4, 6-14 and 16-22 as being anticipated by Gustafsson.

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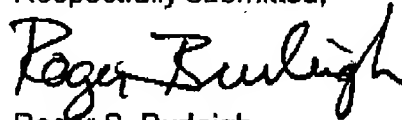
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CONCLUSION

In view of the foregoing amendments and remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-22.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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